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OFFICE OF PETITIONS

In re Application of
Bruce A. Kehr et al.
Application No. 09/845,066
Filed: May 7, 2001
Attorney Docket No. 20010427

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)
: and
: UNDER 37 CFR 1.78(a)(6)
:

This is a decision on the renewed petition filed July 20, 2007, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed non-provisional applications set forth in the amendment filed with the petition. The petition is also treated under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of the prior-filed provisional applications set forth in the amendment filed with the petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A petition filed May 3, 2007 was dismissed in a decision mailed June 22, 2007 because the amendment failed to state the relationship between the applications as required by 37 CFR 1.78(a)(2)(i). With respect to the 371 application, applicant's reference stated this application also claims the benefit of priority under 35 U.S.C. 365(c) from PCT

application No. PCT/US98/0933. However, U.S. Application No. 10/492,710 is the National Stage of International Application No. PCT/US98/0933.

The instant renewed petition corrects the reference to non-provisional application no. 10/492,710 which is the National Stage of International Application No. PCT/US98/0933 and includes that the instant application is a Continuation in Part of application no. 10/492,710.

However, the renewed petition is still dismissed because the amendment does not state the relationship between applications 08/955,952 filed October 22, 1997 and 08/924,917 filed September 8, 1997, as required by 37 CFR 1.78(a)(2)(i). As previously stated, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. Where a nonprovisional application is claiming the benefit under 35 U.S.C. 120 of a prior national stage application under 35 U.S.C. 371, a suitable reference would read "This application is a continuation of U.S. Application No. 08/---, which was the National Stage of International Application No. PCT/DE95/---, filed ---."

Additionally, further review reveals that a proper benefit claim to the prior applications is not set forth in application 10/492,710. A proper benefit claim to a chain of prior applications must include proper references to each prior application in order to establish copendency throughout the entire chain of prior applications. Appropriate references must have been made in each intermediate application in the chain of prior applications. See MPEP 201.11 In other words, it is not sufficient to simply include specific references as to all prior applications. All references must be proper. A benefit claim to a chain of prior applications will only be effective if each prior application actually includes a proper benefit claim. See also Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(c), 1268 OG 89 (March 18, 2003). The amendment is therefore unacceptable and before a petition for delayed claim to priority under 37 CFR 1.78(a)(3) and (a)(6) can be granted in the present application, petitioner must file a grantable petition under 37 CFR 1.78(a)(3) and (a)(6) in application 10/492,710.

Finally, the reference to add the prior-filed applications on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new

matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b). A review of the amendment reveals that it at least improperly incorporates by reference several of the prior applications. Any amendment submitted on renewed petition should be carefully reviewed to ensure that it does not include an improper incorporation by reference statement.

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 or 37 CFR 1.76(b)(5)) to correct the above matters are required. Any ADS filed after the application filing date must be signed in accordance with 37 CFR 1.33(b) and must be titled "Supplemental Application Data Sheet". See 37 CFR 1.76.

Petitioner is reminded that the delay in filing a late benefit claim must be unintentional. Accordingly, petitioner should not intentionally delay filing a renewed petition.

Petitioner is also reminded that pursuant to 35 U.S.C. §119(e) the petition under 37 CFR 1.78(a)(6) must be filed during the pendency of the application. Accordingly, any petition in this application or application no. 10/492,710 directed to the benefit claims to the provisional applications must be filed before either application issues as a patent.

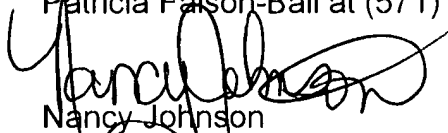
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